

### **REMARKS AND ARGUMENTS**

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 3-14 and 16-20 are presently pending. Claims amended herein are 1, 7, 9, 13, 14 and 20. No claims are cancelled or withdrawn herein.

#### **Claim Amendments**

Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 7, 9, 13, 14 and 20 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references. All amendments are fully supported by the Application and therefore do not constitute new matter. For example, transmitting positioning information after the expiration of a timer can be found at pages 27-29.

## **SUBSTANTIVE MATTERS**

### **Claim Rejections under 35 USC §103**

The Examiner rejects claims 1, 3-14 and 16-20 under 35 USC § 103. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious. Accordingly, Applicant respectfully requests that the rejections based on 35 USC § 103 be withdrawn and the case be passed along to issuance.

The Examiner's rejections are based upon the following references alone and/or in combination:

- **Jones:** *Jones, JR.*, US Patent Publication No. 2001/0052849 A1;
- **Camhi:** *Camhi*, US Patent No. 6,762,684;
- **Silver:** *Silver et al.*, US Patent Publication No. 2007/0082668 A1;and
- **Chaco:** *Chaco*, US Patent No. 7,034,690 B2.

The Examiner cites Jones as the primary reference in the obviousness-based rejections. The Examiner cites Camhi, Silver and Chaco as secondary references in the obviousness-based rejections.

### Obviousness Rejections

#### Lack of Prima Facie Case of Obviousness (MPEP § 2142)

Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

#### Based upon Jones in view of Camhi and further in view of Silver

The Examiner rejects claims 1, 4-11, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Camhi and further in view of Silver. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

#### Independent Claims 1, 9 and 14

Applicant submits that the combination of Jones, Camhi and Silver does not teach or suggest at least the following elements as recited by independent claim 1 (with emphasis added):

- "a positioning controller adapted to determine positioning information for said telecommunications device, wherein the ***positioning information generally corresponds to a location of a user*** of the telecommunication device"
- "wherein said wireless communications controller is adapted to cause positioning information to be transmitted to an associated administration device ***for updating only when a timer expires***, wherein ***the timer resets and restarts*** after transmitting positioning information"

- “a presence controller containing a plurality of ***availability rules defined by the user*** of the telecommunications device, ***wherein the appropriate availability rule is selected depending on a position condition based on positioning information*** of the telecommunications device.”

As for independent claims 9 and 14, they require similar limitations as independent claim 1.

In rejecting the claims, the Examiner admits that Jones fails to disclose or suggest all limitations of the independent claims. With respect to claim 1, the Examiner admits that Jones does not specifically disclose “for longer than a predetermined period after said audible has been generated.” See *Action*, page 3. This issue also applies similarly to claims 9 and 14. See *Action*, pages 7 and 9.

To compensate for the defects of Jones, the Examiner relies on Camhi. In particular, the Examiner directs the Applicant to paragraph column 5, lines 14-23 of Camhi. The Examiner indicated that this portion of Camhi teaches the missing limitations of the independent claims.

Applicant submits that there is no suggestion to combine the references as suggested by the Examiner. Even if the references were to be combined, the addition of Camhi fails to cure at least the admitted defects of Jones.

As indicated by the Examier, the portion of Camhi which is referred to teaches providing “an audible or visual warning to the subject followed by a communication of such out of boundary condition to the central station.” See, e.g., *Action*, pages 7 and 9. As described by Camhi, the out of boundary conditions is defined by an entity which is monitoring an individual wearing the device, not the wearer of the device. For example, the out of boundary condition is defined by the parole officer who is monitoring a

parolee wearing the device. See, e.g., *Camhi*, col.4 at lines 54 -59. In other words, the out of boundary conditions are not defined by the wearer of the device but by one monitoring the wearer of the device.

The present independent claims, on the other hand, require that the device generally indicate the location of the user. To indicate the location of the user, the user must have possession or in general possession of the device. Furthermore, the present independent claims require that the availability rules which depend on positioning information of the device is defined by the user or one who is in general possession of the device.

It appears that the Examiner, in rejecting the claims, equates the out of boundary conditions of *Camhi* with the availability rules of the present claims. Applicant submits that out of boundary conditions are not equivalent to availability rules. Even assuming that they are equivalent, it still fails to teach or suggest the invention of the present independent claims.

In particular, the present independent claims require that the availability rules are defined by the user. As discussed, the user is one who is generally in possession of the device in order to indicate the general location of the user. However, *Camhi* clearly describes that the one who defines the out of boundary conditions is not the one in possession of the device, but an entity monitoring one who is wearing the device. This fact is admitted to by the Examiner. See, e.g., *Action*, page 4.

Furthermore, the present independent claims require that positioning information is transmitted after expiration of a timer and that the timer resets and restarts after transmitting positioning information. *Camhi* merely describes that out of boundary condition are transmitted to the central station in the event the subject does not correct

the out of boundary condition within a specified time interval. See *Camhi*, col. 3 at lines 19-23. *Camhi* nowhere teaches or suggests restarting the timer after positioning information is transmitted. Jones, like *Camhi*, also nowhere teaches or suggests this limitation of the independent claims.

To compensate for the admitted defects of Jones and *Camhi*, the Examiner relies on Silver. In particular, the Examiner relies on Silver to teach a presence controller containing a plurality of availability rules defined by the user. Applicant submits that there is no suggestion to combine Silver with either Jones or *Camhi*.

In order to determine obviousness, it is necessary to look at the interrelated teachings of the multiple patents and the background knowledge possessed by a person having ordinary skill in the art to determine whether there was an apparent reason to combine the known elements in the fashion as claimed. Furthermore, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," *KSR Int'l Corp. v. Teleflex, Inc.* Slip Op. at 14 (U.S. Apr. 30, 2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

The Examiner's reason for combining the references is both Jones and Silver disclose a presence controller that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the teachings of Silver into the teachings of Jones and *Camhi* for the purposes of automatically directing calls based on user's location so that no communication will be missed." See *Action*, bottom of page 4 to top of page 5.

Applicant submits that the Examiner's reason is merely conclusory without any rational underpinning to support the legal conclusion of obviousness. The Examiner, in concluding obviousness, has overlooked or failed to take into consideration the interrelationship of the references and the background knowledge possessed by a person having ordinary skill in the art to determine whether there was an apparent reason to combine the known elements in the fashion as claimed. *See, KSR* at 14.

Silver describes a system for selecting a user's profile based on location of a device of the user. Calls to the user are routed to the user based on the user's call routing preferences and the location of the device. *See Silver*, Abstract.

Jones describes a wireless communications device which is worn by a wearer in order to monitor the wearer's whereabouts. If the wearer's current geographical location is outside of allowable geographical locations as defined by the boundary rule set, the breach is sent to an endpoint to notify the user who is monitoring the wearer of the device. *See, e.g., Jones*, paragraph 23. Such devices, for example, are used by parents (users) to monitor the whereabouts of their child (wearer). *See, e.g., Jones*, paragraph 17.

Clearly as described by Jones, the user of the wireless communications device is the one that is monitoring the whereabouts of a wearer, not the wearer of the device. Breaches by the wearer of the communications device are communicated to the user (one monitoring the wearer) at an endpoint based on routing conditions which defines when that particular endpoint is designated to receive notification of the breach.

As such, the user of Silver and the user of Jones are quite different and would have different objectives. In fact, in the context of Jones, one would not have the wearer of the device which indicates his/her location to define the availability rules.

Common sense would dictate that if the wearer were to define the availability rules, the wearer would define it in such a way that person or user monitoring the wearer would never be informed of the breach. This would be contrary to the objective of the invention of Jones as well as the Examiner's basis for combining Silver with Jones ("...so that no communication will be missed."). See *Action*, page 11. Applicant therefore submits that one of ordinary skill in the art would not combine the references as suggested by the Examiner.

Even if there were a suggestion to combine the references, such a combination would still fail to render the present independent claims unpatentable. For example, at least the limitation that positioning information is caused to be transmitted to an associated administration device for updating only when a timer expires and wherein the timer resets and restarts after transmitting the positioning information is nowhere taught or suggested by Jones, Camhi and Silver, alone or in combination.

As shown above, the combination of Jones, Camhi and Silver does not teach or suggest all of the elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

**Dependent Claims 4-8, 10 and 11**

These claims ultimately depend upon independent claim 1, 9 or 14. As discussed above, independent claims 1, 9 and 14 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.



**Based upon Jones and Camhi and Silver and further in view of Chaco**

The Examiner rejects claims 3, 12, 13 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Jones and Camhi and Silver as applied to claims 1 and 14 above, and further in view of Chaco. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

**Dependent Claims 3, 12, 13 and 16-20**

These claims ultimately depend upon independent claim 1, 9 or 14. As discussed above, claims 1, 9 and 14 are patentable over Jones, Camhi and Silver, alone or in combination. In particular, the Examiner relies on Chaco to teach missing limitations of dependent claims 3, 12, 13 and 16-20. Even if Chaco can be combined as suggested by the Examiner, the defects of Jones, Camhi and Silver with respect to the independent claims are not cured. Applicants therefore submit that claims 3, 12, 13 and 16-20 are patentable over Jones, Camhi, Silver and Chaco, alone or in combination.

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**Conclusion**

In view of the foregoing, Applicant believes that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Should the Examiner believe that a telephone conference would expedite prosecution of this application, please telephone or email me at your convenience.

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Respectfully submitted,



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